

Application No. 10/800,573
Filed: March 15, 2004
TC Art Unit: 1797
Confirmation No.: 1722

REMARKS

This application is subject to a restriction requirement. Applicant hereby confirms the provisional election, with traverse, of Group I, claims 1-13, for examination at this time. Claims 14-18 are hereby cancelled as being drawn to a non-elected invention. Applicant reserves the right to file continuing applications to continue the prosecution of the restricted claims.

Claims 1, 2, 7 & 8 have been rejected as anticipated by U.S. Patent No. 2,875,563 ('563) to Moore. Claims 3-6 and 9-13 have been rejected as obvious over Moore ('563) in view of a number of cited secondary references. These rejections are respectfully traversed and reconsideration is requested.

The Applicant expresses appreciation for the opportunity for his undersigned attorney to conduct a telephone interview with Examiner Ramdhanie and his supervisor, Examiner Griffin, on December 6, 2007. In that interview, the prior art and, in particular, the Moore patent (US 2,875,563), were discussed. In the Office Action dated October 26, 2007, Examiner Ramdhanie cited Moore as anticipating the method of claims 1, 2, 7 & 8. Claim 1 recites a "method of covering an opening in a laboratory container with aluminum foil . . . [by] providing a preformed aluminum foil cup of sufficient size to cover said opening . . . and compressing the sidewall of said cup to a friction fit around said opening" so as to form a heat-resistant and solvent-resistant closure (emphasis added). The undersigned attorney pointed out that, in contrast, Moore teaches an aluminum container, not an aluminum cover, wherein the invention lies in the provision of a "novel arrangement of an applied adhesive material" (col. 1, lines 59-64) "to positively seal the closure upon the unruly ridged rim surface

-5-

WEINGARTEN, SCHURGIN,
GAGNEDIS & LEBOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

Application No. 10/800,573
Filed: March 15, 2004
TC Art Unit: 1797
Confirmation No.: 1722

of the container in liquid tight seam forming relationship" (col. 1, line 72 - col. 2, line 2, emphasis added). As the undersigned attorney explained, the container of Moore could not simply be inverted to obtain the Applicant's invention as Moore never taught compressing his aluminum container around anything. Instead, covers for the Moore container, either those of the prior art or those taught according to the Moore invention, are crimped "on" (col. 1, line 36) or adhesively sealed "upon" (col. 2, line 1) "the unruly ridged rim surface" (col. 2, line 1) of the aluminum container. In other words, the container of Moore itself was never crimped to provide this fit. It was the other way around.

The Examiner and his supervisor indicated in the interview that they understood the undersigned attorney's argument and, following review of the written argument, would consider allowance of the claims. Applicant's full argument is presented below.

Claims 1, 2, 7 & 8 are Not Anticipated by U.S. Patent No. 2,875,563 to Moore Under 35 U.S.C. § 102(b)

As the Applicant described above, Moore teaches an aluminum container, not an aluminum cover, wherein the invention lies in the provision of a "novel arrangement of an applied adhesive material" (col. 1, lines 59-64) "to positively seal the closure upon the unruly ridged rim surface of the container in liquid tight seam forming relationship" (col. 1, line 72 - col. 2, line 2, emphasis added). As the undersigned attorney explained, the container of Moore could not simply be inverted to obtain the Applicant's invention as Moore never taught compressing his aluminum container around anything. Instead, covers for the Moore container, either those of the prior art or those taught according

Application No. 10/800,573
Filed: March 15, 2004
TC Art Unit: 1797
Confirmation No.: 1722

to the Moore invention, are crimped "on" (col. 1, line 36) or adhesively sealed "upon" (col. 2, line 1) "the unruly ridged rim surface" (col. 2, line 1) of the aluminum container.

Referring now to the specific citations of the Examiner to Moore, Applicant submits that in many of these citations, the Examiner has misinterpreted the teachings of the Moore patent. As one example, the Examiner has cited to the first paragraph, beginning at col. 1, line 15. The Examiner has tried to characterize the aluminum container of Moore as an object that could be placed over an opening in another container. However, Moore always characterizes the aluminum container as being essentially rigid, as itself having an open mouth upon which is placed a sealing closure. "Hence, the rim surface around the mouth is interrupted with closely spaced ridges of raised metal that forms in the wall transverse of the top periphery surface plane of the particular container. These unruly ridges of pleated metal therefore make these containers exceptionally difficult to seal tightly with an attached closure" (col. 1, lines 28-34, emphasis added). The Examiner's interpretation of col. 1, lines 35-38, is particularly erroneous. The Examiner cites to this passage as teaching the Applicant's method step of "compressing the sidewall of said cup to a friction fit." However, the cited text teaches the exact opposite. In fact, it discloses "lid closures of various types [and of unnamed materials] that are crimped on the [aluminum] container body." In other words, the container of Moore itself was never crimped to provide a friction fit. It was the other way around. The Examiner can come to this rejection only by impermissible hindsight use of the Applicant's disclosure.

-7-

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

Application No. 10/800,573
Filed: March 15, 2004
TC Art Unit: 1797
Confirmation No.: 1722

Thus, Moore does not disclose all the limitations of claim 1, nor of claims 2, 7 & 8 dependent thereon and so cannot anticipate the recited claims. Therefore, the rejection for anticipation is overcome.

Claims 3-6 and 9-13 are Not Obvious Under 35 U.S.C. § 103 Over U.S. Patent No. 2,875,563 to Moore in Combination with Certain Secondary References

Moore is characterized by the Applicant as described above and the deficiencies of Moore have been identified. Applicant submits that none of the cited secondary references, either alone or in combination, provides the limitations of Applicant's method claims that are missing in the teachings of Moore. Therefore, a combination of Moore with any, or even all, of the cited secondary references still would not provide for a *prima facie* rejection for obviousness. Thus, the Examiner's rejection for obviousness has been overcome.

Application No. 10/800,573
Filed: March 15, 2004
TC Art Unit: 1797
Confirmation No.: 1722

The Applicant submits that all claims in restriction Group I are in condition for allowance and such action is requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

DANIEL PERLMAN

By: Holliday C. Heine
Holliday C. Heine, Ph.D.
Registration No. 34,346
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

HCH/aft/365952.1

-9-

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313